



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,732	09/22/2003	Sang Chul Kang	JP920020142US1	9679
23550	7590	10/17/2008		
HOFFMAN WARNICK LLC 75 STATE STREET 14TH FLOOR ALBANY, NY 12207			EXAMINER LE, KHANH H	
			ART UNIT 3688	PAPER NUMBER
			NOTIFICATION DATE 10/17/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

Office Action Summary

Application No.

10/667,732

Applicant(s)

KANG ET AL.

Examiner

KHANH H. LE

Art Unit

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/10/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/10/2008 has been entered.

This Office Action is in response to the Amendment and Response filed on 07/10/2008 which has been entered. Claims 1-18 were pending. Claims 5-6, 9-18 are cancelled. Thus claims 1-4, 7- 8 are currently pending and considered below. Claims 1, and 2, are independent.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1-4 and 7-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 1 and 2: "obtaining at a user computer" is confusing since "a user" is already claimed in the preamble, i.e. are two different users involved? Please correct to "obtaining at the user computer";

also "displaying.. in accordance with the advertisement information" is confusing since the "advertisement information" is made up of at least 3 data: the address of the ad on an ad

server , effective display period and display location information, so it is not clear what exactly controls the displaying.

Claim 1: at the end of the claim, "for the same URL" is confusing as there are several URL's claimed earlier. To overcome the rejection, " for the same URL entered by the user" is suggested.

Same issue with claim 2: at the end of the claim, "for the same URL and search keyword".

Claims 3-4, 7-8 are rejected as being dependent upon rejected base claims 1 or 2.

Claim 7 is claimed as dependent of claim 5 which has been cancelled. It is interpreted it depends on claim 1 since instant claim 1 is a combination of previous claims 1, 5 and 6. Appropriate correction is required.

Remarks

4. Specification, (at [0004] of US PGPub. 20040059632 version):

" In this regard, co-pending U.S. patent application Ser. No. (IBM docket No. JP9-2001-0343), which is commonly assigned and is incorporated by reference herein, .."

should be amended to

" In this regard, co-pending U.S. patent application Ser. No. 10/263,217 (IBM docket No. JP9-2001-0343), which is commonly assigned and is incorporated by reference herein, .."

If Ser. No 10/263,217 issues as patent, the incorporation should refer to the patent number too.

Response to Arguments

5. Applicant's arguments have been fully considered but they are not persuasive. Claims 1 and 2 are essentially combinations of previously presented claims 1, or 2 with

previously presented claims 5 and 6. These claims were addressed before and no persuasive argument was presented to rebut the prima facie case except a statement that the prior art taken alone or in any combination fails to disclose each and every feature set forth in claim 1. Upon further review of the prior art, however, it is found that Hoyle also teaches the feature that Blaser was used for thus Blaser is no longer needed. The previous rejections as to previously presented claims 5 and 6 are incorporated in the rejections of current claims 1 and 2 as set forth below.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-4, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle US 6,141,010 A in view of Official Notice.**

Independent claim 1:

Hoyle discloses:

A method, system and computer readable medium stored thereon program instructions executable by a computer to perform providing an advertisement to a user over the Internet, the method comprising the steps of:

obtaining at a user computer (*by storing operation unit which operates the CPU-- Figure 1 item 14 and associated text; col. 6 line 62 to col. 7 line 13*) from a first server (which can be

called an ad control server) (Figure 1 item 22 : ADM server 2; col. 8 lines 30-40) a plurality of web page URLs (Figure 7 item “associated links”, e.g. ww.lotus.com and associated text);

and associated advertisement information for each of the web page URLs (Figure 7 and associated text; e.g. “destination links”, “categories”), said advertisement information including an address at which associated advertisement data is stored (Figure 7, item “destination links”, and associated text; col.16 lines 24-37 ; or col. 16 lines 37-44);

and storing (*by the storing operation unit which operates the CPU-- Figure 1 item 14 and associated text; col. 6 line 62 to col. 7 line 13*) said advertisement information in a local storage (“Banner storage” item 30 in user computer 18 in Figures 1, 2 or 4 and associated text; Figure 7 and associated text; col. 16 lines 37-44)

detecting (*by a detecting operation unit which operates the CPU--Figure 1 item 14; col. 6 line 62 to col. 7 line 13*) an URL that the user enters on a web browser (e.g. col. 15 lines 54-59 ; col.16 lines 24-37: ‘recognizing the website being accessed”);

retrieving (*by a retrieving operation unit which operates the CPU --Figure 1; col. 6 line 62 to col. 7 line 13*) from the local storage the advertisement information associated with the detected URL (e.g. col. 16 lines 41-44);

reading from the advertisement server (Figure 3 item 22: ADM server 22; col.16 lines 37-44) the associated advertisement data at the advertisement address included in the retrieved advertisement information (col. 16 lines 41-44), and providing the associated advertisement data from the advertisement server to the user computer over the Internet (col. 16 lines 37-44) ;

and displaying (*by a displaying operation unit which operates the CPU--Figure 1 item 12; col. 6 line 62 to col. 7 line 13*) the associated advertisement data in accordance with the advertisement information (col. 16 lines 37-44).

As to the ad information including information on an effective display period of time , this was previously discussed with respect to now cancelled claims 5 and 13 (see Office Action of 05/30/2008 at page 8).

As discussed earlier, Hoyle does not specifically disclose such (even though HOYLE discloses the ad data includes other data including a number of times a particular ad can be displayed (col. 15 lines 54-58; col. 12 lines 5-6).

However Official Notice is taken that an “effective display period of time” is only a common alternative for a number of times of display, for the same purpose of limiting the time of exposure of a particular ad so others can be displayed (Hoyle, col. 15 lines 58-59).

Because it is obvious to use common alternative means to achieve the same goal, if desired, it would have been obvious to a person having ordinary skill in the art at the time the invention was made (herein a “PHOSITA”) to replace Hoyle’s number of times of display for an ad with an “effective display period of time” for the same ad, so to limit the time of exposure of a particular ad so others can be displayed (Hoyle, col. 15 lines 58-59).

Also, Hoyle does not specifically disclose display location information of the advertisement. However it discloses a banner region 78 (col. 9 lines 26-57; Figure 5 item 78), and the ad data can includes other specifying data (col. 15 lines 54-55). Thus it would have been obvious to a PHOSITA to add to Hoyle’s ad data, display location information of the ad to effect displaying the ad in the desired user screen region. As discussed in Hoyle, such display control techniques as well-known (col. 9 lines 26-57), thus obvious to implement.

As to deciding the validity of the advertisement to be displayed by determining if the effective display period of time for the advertisement to be displayed has expired , this was discussed earlier with respect to now cancelled claims 6 and 14 (see Office Action of 05/30/2008 at page 8), Hoyle, col. 12 lines 5-6, discloses an allotted number of times to display each ad, and mentions a timer, thus this reads on “determining if the effective display period of time for the

advertisement to be displayed has expired” thereby also reading on ” deciding the validity of the advertisement to be displayed”.

As to “wherein different advertisements can be displayed, each advertisement having a different effective display period of time, for the same URL”, this is a statement of effect. In the system of Hoyle, modified as above-discussed, since different ads would be displayed per effective time allotted, the effect would be that different ads would be displayed, based on the same URL entered by the user (Hoyle col. 15 lines 54-59).

7. Independent claim 2:

Hoyle discloses:

A method, system and computer readable medium stored thereon program instructions executable by a computer to perform providing an advertisement to a user over the Internet, the method comprising the steps of:

obtaining from a first server (Figure 1 item 22 : ADM server 2; col. 8 lines 30-40) a plurality of web page URLs and search keywords (Figure 7 item “associated links” and associated text; col.16 lines 1-8) and associated advertisement information for each of the web page URLs and the search keywords (Figure 7 and associated text; e.g. “destination links”, “categories”; col.16 lines 1-8; col.16 lines 24-37), said advertisement information including an address at which associated advertisement data is stored (Figure 7, item “destination links”, and associated text; col.16 lines 37-44);

and storing (*by the storing operation unit which operates the CPU-- Figure 1 item 14 and associated text; col. 6 line 62 to col. 7 line 13*) said advertisement information in a local storage (“Banner storage” item 30 in user computer 18 in Figures 1, 2 or 4 and associated text; Figure 7 and associated text; col.16 lines 37-44);

detecting *(by a detecting operation unit which operates the CPU--Figure 1 item 14; col. 6 line 62 to col. 7 line 13)* an URL and a search keyword that the user enters on a web browser (col.16 lines 24-37: 'recognizing.. the website being accessed,..the keywords used');

retrieving *(by a retrieving operation unit which operates the CPU --Figure 1; col. 6 line 62 to col. 7 line 13)* from the local storage the advertisement information associated with the detected URL and the search keyword (col.16 lines 24-37; col.16 lines 37-44);

reading from the advertisement server (Figure 3 item 22: ADM server 22; col.16 lines 37-52) the associated advertisement data at the advertisement address included in the retrieved advertisement information (e.g. col.16 lines 37-44);

and displaying *(by a displaying operation unit which operates the CPU--Figure 1 item 12; col. 6 line 62 to col. 7 line 13)* the associated advertisement data in accordance with the advertisement information (e.g. col. 16 line 35).

As to the ad information including information on an effective display period of time , this was previously discussed with respect to now cancelled claims 5 and 13 (see Office Action of 05/30/2008 at page 8).

As discussed earlier, Hoyle does not specifically disclose such (even though HOYLE discloses the ad data includes other data including a number of times a particular ad can be displayed (col. 15 lines 54-58; col. 12 lines 5-6).

However Official Notice is taken that an "effective display period of time" is only a common alternative for a number of times of display, for the same purpose of limiting the time of exposure of a particular ad so others can be displayed (Hoyle, col. 15 lines 58-59).

Because it is obvious to use common alternative means to achieve the same goal, if desired, it would have been obvious to a PHOSITA to replace Hoyle's number of times of display for an ad with an "effective display period of time" for the same ad, so to limit the time of exposure of a particular ad so others can be displayed (Hoyle, col. 15 lines 58-59).

Also, Hoyle does not specifically disclose display location information of the advertisement. However it discloses a banner region 78 (col. 9 lines 26-57; Figure 5 item 78), and the ad data can includes other specifying data (col. 15 lines 54-55). Thus it would have been obvious to a PHOSITA to add to Hoyle's ad data display location information of the ad to effect displaying the ad in the desired user screen region. As discussed in Hoyle, such display control techniques as well-known (col. 9 lines 26-57), thus obvious to implement.

As to deciding the validity of the advertisement to be displayed by determining if the effective display period of time for the advertisement to be displayed has expired , this was discussed earlier with respect to now cancelled claims 6 and 14 (see Office Action of 05/30/2008 at page 8), Hoyle, col. 12 lines 5-6, discloses an allotted number of times to display each ad, and mentions a timer, thus this reads on "*determining if the effective display period of time for the advertisement to be displayed has expired*" thereby also reading on " deciding the validity of the advertisement to be displayed".

As to "wherein different advertisements can be displayed, each advertisement having a different effective display period of time, for the same URL" , this is a statement of effect. In the system of Hoyle, modified as above-discussed, since different ads would be displayed per effective time allotted, the effect would be that different ads would be displayed, based on the same URL and search keyword entered by the user (Hoyle col. 15 lines 54-59) .

Claims 3-4:

HOYLE modified as discussed above discloses a method and system as in Claims 1-2 above and HOYLE further discloses wherein the web page URLs and the search keywords are

represented by regular expressions (Figure 3, e.g. URL is www.sports.com; keyword is sports or stocks).

(Note: Since the only relevant paragraph [0031] of the published version of the specification-- US 20040143496-- fails to specifically define "regular expressions", this phrase is interpreted as any expression such as a English terms e.g. "sports").

Claim 8:

HOYLE modified as discussed above discloses a method and system as in claim 1 above. Hoyle further discloses the advertisement control server and the advertisement server are the same server (Figure 1 item 22 : ADM server 2; col. 8 lines 30-40).

Note: also it is admitted it is within the level of skill in the art to make the advertisement control server and the advertisement server are the same server.

(See Specification at [0027])

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle as applied to claim 1 above, and further in view of Nicholas III, US 6,865,719.

Claim 7:

HOYLE modified as discussed above discloses a method and system as in claim 1 above.

However, Hoyle does not disclose wherein said step of displaying further comprises the step of determining if the advertisement will be displayed within a web browser or outside the web browser, based on the display location information.

However, Nicholas discloses ads shown inside or outside of the browser (Figure 4A items 408 and associated text; col. 7 lines 55 col. 8 line 8). It would have been obvious to a PHOSITA to add this teaching of Nicholas to Hoyle to allow the ad to display where the user 's focus is best (Nicholas, col. 2 lines 53-67).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James W. Myhre can be reached on 571-272-6722. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314). Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Khanh H. Le/

Examiner, Art Unit 3688

October 14, 2008